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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,056	12/21/2001	Kevin John Kapsner	11642.24USU1	9778
23552	7590	10/17/2003	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			VASUDEVA, AJAY	
			ART UNIT	PAPER NUMBER
			3617	

DATE MAILED: 10/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/027,056	KAPSNER ET AL.
	Examiner	Art Unit
	Ajay Vasudeva	3617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 04 August 2003.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 13 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a)  The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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## **DETAILED ACTION**

### *Abstract*

1. Applicant is reminded that a patent abstract should be directed not only to the entire disclosure of the patent, but should also include the claimed matter which is new in the art to which the invention pertains. The abstract should describe the disclosure sufficiently to assist readers in deciding the patentable feature of the invention, and whether there is a need for consulting the full patent text for details.

The abstract should include language that refers generally to the matter being claimed in the independent claim 13, referring specifically to the method of mounting the sundeck to a boat.

### *Specification*

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter in claim 13. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

- (A) The sundeck having a first leg and a second leg (line 2)
- (B) The first leg of the sundeck connected to the second leg at an angle, the first leg being shorter than the second leg, and each of the legs having first and second surfaces (lines 2-3).

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(C) Maneuvering the clamp so that a middle section of the first leg of the sundeck is positioned between the clamping members such that the two clamping members face first and second surfaces of the first leg (lines 6-8).

NOTE: The applicant may note that all claimed matter must provide proper antecedent in the specification, as originally filed. Introducing or claiming new matter in an amendment, that is not supported in the specification as originally filed, is not permitted.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 13 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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In the claim 13, applicant claims a method of mounting a sundeck to a boat, the sundeck

- (A) having a first leg and a second leg; and
- (B) the first leg of the sundeck connected to the second leg at an angle, the first leg  
being shorter than the second leg, each of the legs having first and second surfaces,  
and
- (C) the method including the step of maneuvering the clamp so that a middle section of  
the first leg of the sundeck is positioned between the clamping members such that  
the two clamping members face first and second surfaces of the first leg (lines 6-8).

However, it is noted that by adding the above highlighted limitations, applicant has introduced and claimed new matter that is not supported in the specification, as originally filed. The specification neither discloses the sundeck having two legs or the legs being arranged as claimed, nor does it disclose a step of maneuvering the clamp with respect to the sundeck, as highlighted above.

***Allowable Subject Matter***

5. Claim 13 will receive a favorable consideration for allowance if the rejection(s) under 35 U.S.C. 112, first paragraph, set forth in this Office action is overcome.

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6. The rejection(s) under 35 U.S.C. 112, first paragraph, set forth in this Office action, can be overcome by filing a Continuation-In-Part (CIP) application in order to provide support in the specification for such claimed matter which has been deemed new matter in the above rejection.

***Response to Arguments***

7. Applicant's arguments with respect to claim 13 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajay Vasudeva whose telephone number is (703) 306-5992.



S. JOSEPH MORANO  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600



AV

October 15, 2003